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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,059

Applicant(s)

PASTRO ET AL.

Examiner

THOMAS RICHARDSON

Art Unit

2444

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 47-66 are pending for examination.

Claims 1-46 have been cancelled.

Claims 47-66 are newly added.

Claims 47-66 are rejected.

Response to Arguments

1. Applicant's arguments with respect to newly added claims have been considered but are not persuasive. Applicant argues no cited reference discloses newly claimed limitations. Examiner disagrees.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 47-62 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0021397, Wengrovitz, US 2009/0125591, Kirkpatrick.

4. As per claim 47, Wengrovitz teaches an apparatus for performing instant messaging under a first protocol, the apparatus comprising:

a first device implementing the first protocol (Figure 1, PC 40);

a second device implementing a second protocol, the second protocol being different than the first protocol and incompatible with the first protocol, the second device being a telephonic switch (Figure 1, telephone 30, also paragraphs 22-23, where the second device may utilize SIP, and the first may utilize PBX and CSTA protocols);

a protocol converter to convert between the first protocol and the second protocol (paragraph 23, where the message is translated for delivery to the telephonic device);

a register to register the first device and the second device (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions);

a map to map a first client to the first device and a second client to the second device (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions);

the telephonic switch being connected to the second client, the second client being a digital display telephone set that receives and sends instant messaging messages to and from the first client without needing to be off-hook, the digital display telephone set having a plurality of keys and a display (paragraphs 20-21, where the telephony appliance may include a display, keypad, and function buttons, and where it may be connected to a telephone switching device in order to provide text messaging functionality, also paragraph 32, where a message may also be received while the telephone is off-hook); and

the second device having full control of the display on that digital display telephone set (paragraph 32, where the PBX may utilize commands to control the telephone, including the telephone display).

Wengrovitz does not expressly teach receiving information for keys pressed at a recipient device. Kirkpatrick teaches an instant messaging proxy comprising:

a first device implementing a first protocol (paragraph 34, where the wireless device utilizes an IM protocol);

a second device implementing a second protocol, wherein messages in said first protocol are incompatible with said second protocol (paragraph 34, where the service-specific protocols may be used with other IM services, also paragraph 32, where each instant messaging service uses a different, incompatible protocol); and

the second device receiving information for the keys pressed at the digital display of the second client (paragraph 24, where requests from the wireless device may be interpreted by the service to perform internet activities).

It would have been obvious to utilize a protocol conversion such as taught by Kirkpatrick in a communication system such as taught by Wengrovitz. Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). It would be beneficial in such a system to utilize a protocol conversion with instant messaging such as that taught by Kirkpatrick, as the protocol conversion allows multiple device types to communicate with each other, and a user to send messages to another user regardless of the device types of the sending and receiving users (paragraph 14).

5. As per claim 48, Wengrovitz-Kirkpatrick further teaches the first protocol is a Session Initiation Protocol (SIP) (Wengrovitz, paragraph 22, where SIP may be utilized, also paragraph 52, where SIP sets may operate in a peer to peer mode without a master controller).

6. As per claim 49, Wengrovitz-Kirkpatrick further teaches the first client of the first device is a personal computer or a personal digital assistant (PDA) and the first device is an SIP proxy server (Wengrovitz, paragraph 22, where SIP may be utilized by the PC client).

7. As per claim 50, Wengrovitz-Kirkpatrick further teaches the digital display telephone set has an instant messaging key that initiates instant messaging in the digital display via actuation of the instant messaging key (Wengrovitz, paragraph 32-34, where messages may be displayed and scrolled through by the user at the recipient device).

8. As per claim 51, Wengrovitz-Kirkpatrick further teaches the digital display telephone set is a digital telephone or a telephone client (Figure 1, telephone 30).

9. As per claim 52, Wengrovitz teaches a method for performing instant messaging comprising:

identifying a first device implementing a first protocol (Figure 1, PC 40);

identifying a second device implementing a second protocol, the second protocol being a computer supported telephony application protocol that is different than the first protocol and incompatible with the first protocol and the second device begin a telephonic switch (Figure 1, telephone 30, also paragraphs 22-23, where the second device may utilize SIP, and the first may utilize PBX and CSTA protocols);

registering the first device and the second device (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions);

mapping a first client to the first device and a second client to the second device, the second client being a digital display telephone set that has a display and a plurality of keys (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions);

converting messages exchanged between the first device and the second device such that the second device receives messages from the first device that are converted from the first protocol to the second protocol (paragraph 23, where the message is translated for delivery to the telephonic device);

communicating instant messaging messages to and from the first client and the second client without the digital display telephone set being off hook (paragraphs 20-21, where the telephony appliance may include a display, keypad, and function buttons, and where it may be connected to a telephone switching device in order to provide text messaging functionality, also paragraph 32, where a message may also be received while the telephone is off-hook); and

the second device having full control of the display of the digital display telephone set when the digital display telephone set communicates the instant messaging messages (paragraph 32, where the PBX may utilize commands to control the telephone, including the telephone display).

Wengrovitz does not expressly teach receiving information for keys pressed at a recipient device. Kirkpatrick teaches an instant messaging proxy comprising:

a first device implementing a first protocol (paragraph 34, where the wireless device utilizes an IM protocol);

a second device implementing a second protocol, wherein messages in said first protocol are incompatible with said second protocol (paragraph 34, where the service-specific protocols may be used with other IM services, also paragraph 32, where each instant messaging service uses a different, incompatible protocol); and

a protocol converter to convert incompatible messages between said first device and said second device to/from said first protocol from/to said second protocol (paragraphs 35 and 36, where the protocol conversion module may convert objects for messages between protocols for devices);

the second device receiving information for the keys pressed at the digital display of the second client (paragraph 24, where requests from the wireless device may be interpreted by the service to perform internet activities).

It would have been obvious to utilize a protocol conversion such as taught by Kirkpatrick in a communication system such as taught by Wengrovitz. Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). It would be beneficial in such a system to utilize a protocol conversion with instant messaging such as that taught by Kirkpatrick, as the protocol conversion allows multiple device types to communicate with each other, and a user to send messages to another user regardless of the device types of the sending and receiving users (paragraph 14).

10. As per claim 53, Wengrovitz-Kirkpatrick further teaches the first protocol is a Session Initiation Protocol (SIP) (Wengrovitz, paragraph 22, where SIP may be utilized,

also paragraph 52, where SIP sets may operate in a peer to peer mode without a master controller).

11. As per claim 54, Wengrovitz-Kirkpatrick further teaches the first client of the first device is a personal computer or a personal digital assistant (PDA) and the first device is an SIP proxy server (Wengrovitz, paragraph 22, where SIP may be utilized by the PC client).

12. As per claim 55, Wengrovitz-Kirkpatrick further teaches the first device is an SIP proxy (Wengrovitz, paragraph 22, where SIP may be utilized by the PC client, also paragraph 52, where SIP sets may operate in a peer to peer mode without a master controller).

13. As per claim 56, Wengrovitz-Kirkpatrick further teaches establishing an instant messaging connection via pressing an instant messaging key of the plurality of keys of the digital display telephone set (Wengrovitz, paragraphs 32-34, where messages may be displayed and scrolled through by the user at the recipient device).

14. As per claim 57, Wengrovitz-Kirkpatrick further teaches sending a notification to the digital display telephone set when a new instant message arrives that was sent from the first client (Wengrovitz, paragraphs 32-34, where messages may be displayed and scrolled through by the user at the recipient device).

15. As per claim 58, Wengrovitz-Kirkpatrick further teaches sending a notification from the first client to the second client when a request to add the second client to a contact list of the first client is received (Wengrovitz, paragraphs 25-27, where a list of

recipients may be created, and where messages may be accepted by a recipient based on a list of acceptable sender devices).

16. As per claim 59, Wengrovitz-Kirkpatrick further teaches the second client signing in to receive instant messaging services (Kirkpatrick, paragraph 11, where users must be signed on to participate in an IM session).

17. As per claim 60, Wengrovitz-Kirkpatrick further teaches the second client changing a status from off-line to on-line for instant messaging (Kirkpatrick, paragraph 11, where users must be signed on to participate in an IM session).

18. As per claim 61, Wengrovitz-Kirkpatrick further teaches the second client querying a status of a contact list member (Kirkpatrick, paragraph 31, where user status is maintained).

19. As per claim 62, Wengrovitz-Kirkpatrick further teaches determining a presence status of the second client based on call activity of the second client (Kirkpatrick, paragraph 31, where user status is maintained).

20. As per claim 66, Wengrovitz-Kirkpatrick further teaches the digital display telephone set is a digital telephone or a telephone client (Figure 1, telephone 30).

21. Claims 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0021397, Wengrovitz, US 2009/0125591, Kirkpatrick as applied to claim 52 above, and further in view of US 2005/0013421, Chavez et al.

22. As per claim 63, neither Wengrovitz nor Kirkpatrick expressly teaches sending stored common replies to other instant messaging clients. Chavez teaches instant messaging to and from PBX stations comprising:

storing common replies to other instant messaging clients (paragraph 86, where responses may be stored by the device).

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

23. As per claim 64, Wengrovitz-Kirkpatrick-Chavez further teaches at least one of the stored common replies includes at least one custom data field (Chavez, paragraph 86, where responses may be stored by the device).

24. As per claim 65, Wengrovitz-Kirkpatrick-Chavez further teaches sending stored messages to other instant messaging clients (Chavez, paragraph 86, where responses may be stored by the device).

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS RICHARDSON whose telephone number is (571) 270-1191. The examiner can normally be reached on Monday through Thursday, 11am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TR
/William C. Vaughn, Jr./
Supervisory Patent Examiner, Art Unit 2444